

## **REMARKS/ARGUMENTS**

This paper is filed in response to the office action mailed on August 9, 2004. In the office action, claims 5 and 10 are objected to due to some informalities. The informalities cited in the office action do not match the copy of the amendment in applicant's file. Therefore, applicant assumes that the informalities were created during the computerized faxing process. A hard copy of this office action is submitted which applicant believes will meet the examiner's approval. Thus, the objections to claims 5 and 10 are traversed.

Next, claims 1-10 and 13-15 are rejected under 35 U.S.C. § 112, first paragraph for allegedly not complying with the enablement requirement. Applicant respectfully traverses this rejection. The rejection states that the specification does not provide enablement "for the encryption/decryption of game data 'during operation'" of the gaming machine. The office action then goes on to cite paragraphs 38, 52 and 61 for the proposition that encryption/decryption does not take place during operation of the gaming machine.

Applicant respectfully submits that the Patent Office has misinterpreted the claims. The claims recite the encryption and decryption of operational code that is used to run the gaming machine. The claims have been amended to make it clear that the encrypted and decrypted operational code or operating data includes at least one of video data or audio data which effects the operation of the machine during the playing of a game on the machine by a player.

Paragraph 8 is one example in the specification that makes it clear that the code that is being encrypted and decrypted includes audio and video data. This is in contrast to U.S. Patent No. 6,264,557 ("Schneier") which is a security technique for network or Internet gaming whereby only player identification or random numbers are encrypted and decrypted, not operating code. This is also in contrast to U.S. Patent No. 5,643,086 ("Alcorn") which is directed toward a hash function and not the encrypting and decrypting of operational code that is actually used by the gaming machine. Applicant respectfully submits that the claims are in full compliance with 35 U.S.C. § 112.

Next, the office action rejects claims 1-10 and 14-17 under 35 U.S.C. § 102(e) as allegedly being anticipated by Schneier. Applicant respectfully traverses this rejection.

With claims 1, 5, 10 and 16 as presently amended, Schneier cannot serve as an anticipating reference under M.P.E.P. § 2131, which requires:

[t]o anticipate a claim, the reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.

*Citing, Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987).

Schneier is only directed toward the encryption and decryption of player signatures or player identifications and random numbers, and not operational code. The office action alleges that Schneier teaches the encrypting of operational code with a first private key, which is transmitted to an encryption device and then storing the encrypted code in a memory device. The Patent Office cites Schneier's abstract and RAM 215 for this proposition.

However, the abstract and specification of Schneier makes it clear that only random numbers are transmitted, encoded and decoded. These random numbers are not audio and video operational data and do not effect the audio and visual aspects of a video gaming machine. Schneier is limited only to random number encryption and decryption only and ensuring that random numbers are truly random. Schneier is not directed toward the encryption and decryption of operational code which includes video and audio data. See Schneier at column 1, line 61 to column 2, line 3.

The Patent Office then makes the argument that Schneier "obtains said game device operational code reversibly/symmetrically encrypted with said first private key during game play, citing reference numeral 620 and Figure 15." Reference numeral 620 is only limited to encoding a game server random number with a game server and coding key. Fig. 15 of Schneier is directed toward encoding and decoding a player communication using a symmetric key. Again, neither Fig. 6 nor Fig. 15 of Schneier is directed

toward the encoding and decoding of *operational code that includes audio and video code*.

The Patent Office also relies upon Schneier at column 2, lines 21-29 and column 9, lines 21-36. Again, these passages are directed only toward random number generation, encoding and decoding and not operational code encrypting and decrypting as required by the pending independent claims. Thus, the conclusion at the bottom of page 4 of the office action that Schneier teaches the "utilizing said decrypted code to control at least one aspect of the operation of said gaming device during operation of said gaming device by the player" is misleading because Schneier is limited only to random numbers and player ID, and not operational code that includes audio and video code. Thus, with the clarifying amendments to the independent claims, Schneier is clearly deficient as an anticipating reference.

With respect to the office action's rejection of claims 16 and 17, applicant respectfully submits that Schneier does not teach or suggest the encrypting of first and second portions of operational data with first and second private keys and the decrypting of only one portion of that data with the key that resides in the gaming machine. Schneier is directed toward the encryption and decryption of random numbers, not operation data or separate portions of operational data. The Patent Office relies upon columns 8-10 and the description of Figs. 5-8 in its rejection of claims 16 and 17.

However, in columns 8-10 is the concept of dividing a random number into two parts and separately encrypting different parts of the random number taught or suggested. And, again, random numbers are not operational code or code that controls audio or visual aspects of a game. Applicant respectfully submits that claims 16 and 17, as presently amended, are clearly allowable over Schneier as Schneier does not teach or suggest the separate encryption of different parts of operational code using different keys and the decryption of only a single part of the operational code using one key. Schneier also does not teach or suggest the encryption and decryption of audio and video data for a gaming machine. Therefore, applicant respectfully submits that claims 16 and 17 remain allowable.

Finally, the office action rejects claim 13 under 35 U.S.C. § 103 as being unpatentable over Schneier in view of U.S. Patent Application No.

2002/0071557 ("Nguyen"). Nguyen is commonly assigned with the present application. Nguyen has a filing date of December 7, 2000. The present application has a filing date of June 12, 2001. Applicant in no way is admitting that Nguyen is prior art under § 102(e) as applicant in no way admits that Nguyen was filed before "the invention" claimed herein.

Nevertheless, due to the expense of preparing and filing the necessary declaration to remove Nguyen as a citable reference, applicant traverses this rejection without admitting that Nguyen is prior art.

At the outset, under MPEP §§ 2142 and 2143,

[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

*Citing*, *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); *see also* MPEP § 2143-§ 2143.03 for decisions pertinent to each of these criteria.

No combination of Schneier and Nguyen establishes a *prima facie* case of obviousness for independent claim 10, upon which claim 13 depends. Schneier does not teach or suggest the encrypting and decrypting of operating code which includes audio and video code. Schneier does not teach or suggest the use of such code in a controller during the operation of the gaming device by a player. Neither does Nguyen. Nguyen is only cited for the proposition that it teaches the transfer of software between a remote server and a gaming machine. Nguyen does not teach or suggest the encryption and decryption of operating code that includes audio and video data as required by amended claim 10. Therefore, no combination of Schneier and Nguyen teaches or suggests all of the limitations of amended claim 10 and therefore the hypothetical combination of Schneier and Nguyen

fails to establish a *prima facie* case of obviousness. Accordingly, the obviousness rejection of claim 13 is respectfully traversed.

Applicant respectfully submits that this application is in a condition for allowance and an early so indicating is respectfully requested.

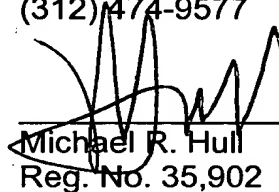
The Commissioner is authorized to charge any fee deficiency required by this paper, or credit any overpayment, to Deposit Account No. 13-2855.

Respectfully submitted,

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